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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/812,296

03/29/2004

Peter B. Risi

1-24403

1805

4859

7590

05/30/2006

MACMILLAN SOBANSKI & TODD, LLC
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EXAMINER

AHMAD, NASSER

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/812,296

Applicant(s)

RISI ET AL.

Examiner

Nasser Ahmad

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 09 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-17 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-17 and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-7, 9-17 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1, the phrase "wherein the adhesive dries and sets firm when fully cured" could not be located in the specification as directed by the applicant. Specifically, page-6, lines 10-13, teaches the about the problem of dry too quickly, while page-5, lines 21-26 teaches the setting firm aspect but fails to teach that the setting firm is based on drying. Hence, said phrase is considered to be new matter.

Claims 6-7, the phrase "at room temperature of 21 C", as recited in the amendment filed on March 9, 2006, is found to be new matter because the specification teaches that the gelled adhesive having the set time but fails to specify the temperature as being room temperature.

Claim 22 (newly submitted in the amendment of March 9, 2006), the phrase "the adhesive when fully cured...8Mpa" is deemed to be new matter because the

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specification clearly teaches that the gelled adhesive strength is at least 8 Mpa (specification, page-5, line 10) but fails to provide support for the phrase as provided in the claim 22.

Rejection Maintained

3. Claims 1-2, 4-7 and 9-10 are rejected under 35 U.S.C. 102(a) as being anticipated by European Patent Application (EP: 1262534) for reasons of record made in the last Office Action of 10/4/05.

Response to Arguments

4. Applicant's arguments filed March 9, 2006 have been fully considered but they are not persuasive.

Applicant argues that the European Patent fails to teach that "the adhesive dries and set firm when cured" and that said phrase is a property of the adhesive and not an intended use of the adhesive. These are not found to be convincing because the claimed product is directed to an adhesive product comprising a backing strip of release material and a gelled adhesive on the backing strip. As for the aspect of "when cured", it is indeed directed to an intended use of the claimed product. Assuming arguendo, if the claimed product is a cured adhesive, as being argued by the applicant, then the adhesive on the backing strip is not a gelled adhesive. This is found to be confusing because it is not clear if the claimed product is directed to a gelled adhesive or not. Hence, examiner has

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taken the position that the claimed product includes the gelled adhesive and not the cured adhesive. Further, regarding said above quoted phrase, it is found to be new matter for lack of support in the specification as discussed above.

Regarding new claim 22 and the amended claims 6-7, applicant is directed to the above discussed new matter concerns.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is anticipated over the prior art as discussed above.

Rejection Withdrawn

5. Claims 3, 11-12 and 15-17 are rejected under 35 U.S.C. 103(a) as being obvious over European Patent Application in view of Columbus (5416140) made in the last Office Action has been withdrawn in view of the amendment filed on March 9, 2006.

Indicated Allowability Withdrawn

6. Claims 13-14, 18 and 19-20 indicated as being objected to and/or allowable in the last Office Action have been withdrawn in view of the newly found prior art.

Response to Arguments

7. Applicant's arguments with respect to claims 3, 11-12, 15-17, 19-20 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-2, 4-7, 9-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Hennen (6982107).

Hennen relates to a transfer adhesive product comprising a backing strip of a release liner (col. 2, lines 1-5) and a gelled adhesive (col. 8, lines 58-63) on the backing strip.

The adhesive is in the form of a layer and is tacky to the touch as it is a pressure sensitive adhesive. The release material is well known in the art to be of low friction, particularly silicone release material (col. 2, lines 22-25). The adhesive can be polyvinyl acetate or polyvinyl alcohol (col. 8, lines 1-11).

The phrase "when cured" is directed to an intended use of the claimed product and hence has not been given any patentable weight because it is not found to be of positive limitation.

Claims 6-7 have not been given patentable weight because it is directed to an intended use of adhesive product with a setting time.

Regarding claim 19, the transfer tape of Hennen provides for the steps of applying the adhesive to a first object, removing the backing strip, and pressing a second object to the adhesive (col. 1, lines 12-30).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3, 11-17 and 19-22 are rejected under 35 U.S.C. 103(a) as being obvious over Hennen (6982107) in view of Dickmann (4325855).

Hennen, as discussed above, fails to teach that the adhesive comprises a gelling agent. Dickmann relates to an adhesive gel comprising an adhesive resin and a gelling agent (abstract). The composition also includes polyvinyl acetate and polyvinyl alcohol (col. 2, lines 35-40), emulsion or dispersing agent (col. 3, lines 3-5) and ionic salt (col.3, lines 26-28). Therefore, it would have been obvious to one having ordinary skill in the art to utilize dickmann's teaching of using a gelling agent with the adhesive resin in the invention of Hennen with the motivation to provide for stabilizing the adhesive gel.

With regards to the adhesive thickness of 1/64-1/16 inch, it would have been obvious to modify the adhesive thickness of Hennen to provide structure and strength to the adhesive, based on optimization through routine experimentation.

For claim 13, it would have been obvious to one having ordinary skill in the art to modify Dickmann by providing phosphate salt as the electrolyte because Dickmann teaches that any suitable ionic salt is usable.

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Regarding claims 20-21, it would have been obvious to use said tape with a cutting step for forming usable length, when unrolled from a roll.

Further, because Hennen's tape is used in painting processes, it would include wood surfaces.

Also, the adhesive strength would be at least 8 Mpa, based on optimization through routine experimentation, for providing optimum adhesion of the adhesive product to a substrate.

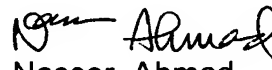
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 5/22/06
Nasser Ahmad
Primary Examiner
Art Unit 1772

N. Ahmad.
May 22, 2006.